

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/902,153 07/29/97 LARRY R. MOORE K 826-1511/100

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WM41/9917

EXAMINER

KINCAID, L

ART UNIT

PAPER NUMBER

2682

DATE MAILED:

08/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/902,153

Applicant(s)

HASHIMOTO, KEN

Examiner

Lester G. Kincaid

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27,32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27,32 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 18.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Appeal and Information Disclosure Statement

Applicant's appeal of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Having withdrawn the finality of the last office action, it is considered that the fee set forth in 37 C.F.R. 1,17 (p) for the IDS filed under 37 C.F.R. 1.97 (d) is not due and won't be charged and therefore the IDS has been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-5 and 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of the term "third party" is confusing and unclear, especially in claims 4 and 13 which requires that the third party hold the information terminal - whom one of ordinary skill in the art may expect to be the "first party", thus raising the question of the limitations of the term "third party", as claimed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2682

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 10, and 32-33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schuchman et al. (U.S. Patent 5,422,813).

See entire document.

Claims 1, 3, 10, 12, 20, 32, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by FitzGerald et al. (U.S. Patent 5,420,594).

See at least col. 1, lines 37-52, col. 2, lines 1-68, col. 3, lines 15-20, col. 4, line 36 through col. 5, line 66.

Claims 1, 3, 4, 10, 12, 13, 20, 23, 24, 32, and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Bruno et al. (U.S. Patent 5,604,765).

See col. 2, lines 20-64, and col. 8, line 47 through col. 10, line 6.

As to **claims 4 and 13**, Bruno et al. disclose everything claimed as applied above to claims 3 and 12, and (as best understood by the examiner considering the indefiniteness cited above) further provide for the position information to the call destination and/or 911 system, both of whom are considered to have an information terminal.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 11, 19, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruno et al. .

As to **claims 2 and 11**, Bruno et al. disclose everything claimed as applied above to claim 1, and further that the terminal independently detects and displays its current position when all of the position systems have become unavailable, (see col. 2, lines 53-64 and col. 8, lines 60-62). Bruno et al. fail to explicitly recite that the device detects a moving direction and speed of the terminal. The examiner takes official notice that it was well known in the art at the time the invention was made for an information terminal to include a built-in device which detects a moving direction and speed of the terminal for providing information to the user, other parties, and/or for providing to the system for aiding in switching decisions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system by specifically including a built-in device which detects a moving direction and speed of the terminal for the purpose of providing information to the user, other parties, and/or for providing to the system for aiding in switching decisions.

As to **claims 19 and 25**, Bruno et al. further disclose that the terminal is a portable telephone type, however fail to explicitly disclose the antenna positioning. The examiner takes official notice that it was well known in the art at the time the invention was made to locate the antenna in a cover of an input section, such as in the "flip portion" of a flip phone for ergonomic reasons. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system by specifically putting the telephone antenna in the flip cover for the purpose of ergonomics.

Claims 6-9, 15-18, 21-22, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruno et al. in view of Obradovich et al. (U.S. Patent 6,148,261).

Bruno et al. fail to explicitly recite the downloading, retaining, and display features, which are disclosed in an analogous art by Obradovich et al. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system by specifically including the downloading, retaining, and display features for the purpose of enabling the terminal to easily and efficiently display the most up to date maps.

Response to Arguments

Applicant's arguments with respect to claims 1-4, 6-13, 15-27, and 32-33 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lester G. Kincaid whose telephone number is (703) 306-3016. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chang, can be reached at (703) 308-6739.

Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service Office at (703) 306-0377 or the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:


Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

LGK
August 13, 2001


**LESTER G. KINCAID
PRIMARY EXAMINER**